

## **REMARKS**

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-5 and 7-14 are pending. Claims 1 and 8 are independent.

Concurrently with this Amendment, Applicants have submitted a substitute specification and a marked-up copy showing the changes made in creating the substitute specification. No new matter has been added in creating the substitute specification.

Claims 1-7 and 12 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse this rejection.

With respect to claim 1, the Examiner indicates it is not clear whether or not the optical disc is part of the apparatus being claimed. By this Amendment, Applicants have revised claim 1 to clearly indicate that the optical disc is not part of the claimed apparatus. However, it should be noted that the apparatus is claimed as being configured for an optical disc.

In view of the above claim amendments, Applicants respectfully request that the Examiner withdraw this rejection.

Claims 4, 6 and 12 stand rejected under 35 U.S.C. §112, first paragraph for failing to comply with the enablement requirement. Applicants respectfully traverse this art grounds of rejection.

With respect to claim 6, Applicants have canceled claim 6, rendering this rejection moot.

With respect to claims 4 and 12, the Examiner questions the Applicants' description of pressure application. On page 7 of the originally filed application, paragraphs [0029] and [0032] both disclose that the frame supplies the scratching unit 30 with pressure. It is then apparent from the figures and the subsequent description that the pressure applied to the scratching unit 30 by the frame 40 is transmitted to the optical disc 20 by the scratching unit 30. Applicants have revised the specification as shown in the substitute specification to clearly indicate this subject matter. Furthermore, the claims have been amended to more accurately claim this subject matter.

As such, it is believed that the Examiner's §112, first paragraph rejection has been obviated, and Applicants respectfully request that the Examiner withdraw this rejection.

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. §103 as being unpatentable over Nakagawa in view of Kobayashi. Applicants respectfully traverse this art grounds of rejection.

The Nakagawa patent is directed towards a method of testing abrasion of automobile brake rotors. In the Nakagawa method, a brake rotor is attached to, for example, a vehicle axle, and then a brake pad material is applied to the rotor at two different pressures.

First, Applicants respectfully submit that Nakagawa is not analogous art to that of the subject invention. The present invention is directed towards testing the endurance of an optical disc, not testing abrasion of brake rotors for automobiles. Why one skilled in the art would look to the automobile brake

rotor abrasion testing art is beyond Applicants' understanding. On this basis alone, Applicants respectfully request that the Examiner withdraw the rejection.

Furthermore, the Examiner will readily appreciate that an apparatus for testing a vehicle brake rotor for abrasion cannot possibly include "a rotation plate configured to rotate an optical disc," as recited in claim 1.

The Kobayashi patent is directed towards a pin-on-disk type wear testing device. In this device, the pin being contacted to a disk is being tested for wear, not the disk. Why one skilled in the art would combine a device for testing the wear of pins with a vehicle brake abrasion testing device is not understood by the Applicants. Kobayashi is also not analogous art to the present invention, and clearly would not be combined with Nakagawa. On these further grounds, Applicants respectfully request that the Examiner withdraw the art grounds of rejection.

Furthermore, as with Nakagawa, Kobayashi does not disclose or suggest "a rotation plate configured to rotate an optical disc," as recited in claim 1.

In view of the above, even if one skilled in the art were to combine Nakagawa with Kobayashi, the resulting device would not include a rotation plate configured to rotate an optical disc as required by claim 1. Therefore, Nakagawa in view of Kobayashi cannot render claim 1 obvious to one skilled in the art.

Claims 2, 4, 5 and 7, dependent upon claim 1, are patentable for the reasons stated above with respect to claim 1 as well as on their own merits.

Claim 6 stands rejected under 35 U.S.C. §103 as being unpatentable over Nakagawa in view of Kobayashi and Cotterill. Applicants have canceled claim 6, rendering this rejection moot.

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Nakagawa in view of Kobayashi and Hupf. Applicants respectfully traverse this art grounds of rejection.

As discussed above, Nakagawa in view of Kobayashi fails to disclose or suggest the invention as recited in claim 1. Furthermore, from even a cursory review of Hupf, it is apparent that Hupf does not overcome the disclosure and suggestion deficiencies of Nakagawa in view of Kobayashi. Therefore, claim 1 is patentable over Nakagawa in view of Kobayashi and Hupf, and claim 3, dependent upon claim 1, is patentable over the combination of these documents at least for the reasons stated above with respect to claim 1.

Furthermore, Hupf teaches using steel wool to test the mechanical durability of a cooking vessel. As is common knowledge, steel wool is often used to clean cooking vessels and therefore is an appropriate material to use in checking the durability of a cooking vessel. Why one skilled in the art would use steel wool for abrasion testing a brake rotor is not understood. Nakagawa clearly teaches using a brake pad. The Examiner has not supplied plausible reason why steel wool would be substituted for a brake pad in the abrasion testing of Nakagawa.

In view of the reasons discussed above, Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

Applicants note with appreciation the Examiner's indication that claims 8-11, 13 and 14 are allowable.

### **CONCLUSION**

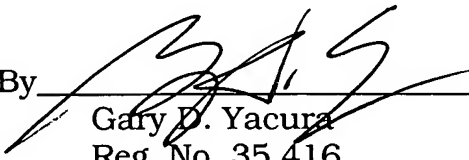
In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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